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| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 09/421,870                      | 10/26/1999  | MARK O. WORTHINGTON  | BURST-3-CIP2        | 4705             |
| 20995                           | 7590        | 07/28/2004           | EXAMINER            |                  |
| KNOBBE MARTENS OLSON & BEAR LLP |             |                      | MARSCHER, ARDIN H   |                  |
| 2040 MAIN STREET                |             |                      | ART UNIT            |                  |
| FOURTEENTH FLOOR                |             |                      | PAPER NUMBER        |                  |
| IRVINE, CA 92614                |             |                      | 1631                |                  |
| DATE MAILED: 07/28/2004         |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/421,870

Applicant(s)

WORTHINGTON, MARK O.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-62,67,69-74,78-80,82,153-203 and 209-211 is/are pending in the application.
- 4a) Of the above claim(s) 13-18,25,153-155,162-177,187-203 and 209-211 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,19-24,26-62,67,69-74,78-80,82,156-161, and 178-186 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6,8-62,67,69-74,78-80,82,153-203, and 209-211 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Applicants' arguments, filed 5/10/04, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### **NEW MATTER**

Claims 1-6, 8-12, 19-24, 26-62, 67, 69-74, 78-80, 82, 156-161, and 178-186 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that that instant independent claims which are under examination have all been amended to require a physical material deposition subsequent to manufacture. Applicants have not pointed to written support as filed for such limitations regarding both what is or is not manufacturing practice and therefore when a step may be performed "subsequent" thereto. Consideration of the instant disclosure as filed reveals that manufacturing practice of optical discs of the instant invention are described on pages 6-9 but nowhere is there any distinction set forth as to what ends manufacturing so that subsequence steps are disclosed as subsequent to manufacturing. This lack of written description as filed thus causes these limitations to be NEW MATTER. This rejection is

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necessitated by amendment. Claims which depend directly or indirectly from said independent claims also contain this NEW MATTER due to their dependence.

### **VAGUENESS AND INDEFINITENESS**

Claims 1-6, 8-12, 19-24, 26-62, 67, 69-74, 78-80, 82, 156-161, and 178-186 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims have been amended to indicate that material is physically deposited "subsequent to manufacture" as, for example, in instant claim 1, lines 4-5. This limitation lacks antecedent basis as to what is meant regarding the end of manufacturing. In order to determine the metes and bounds of this timing which is subsequent to manufacturing, there needs to be some limitation as to what constitutes an end of manufacturing so that a subsequent step is defined as to when it may occur. No such definition of the metes and bounds of manufacturing steps are set forth in the claims thus making them vague and indefinite. Independent claims 22, 49, 67, 70, 78, 79, and 156 also contain this vagueness and indefiniteness via said phraseology. Claims which depend directly or indirectly from said independent claims also contain this unclarity due to their dependence. Clarification via clearer claim wording is requested. This rejection is necessitated by amendment.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-12, 19-24, 26-34, 38, 39, 48-50, 58, 61, 62, 67, 69-74, 78-80, 82, 156-161, and 178 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by DeCusatis et al. (P/N 5,872,723).

This rejection is reiterated and maintained from the previous office action, mailed 1/9/04, and as necessitated by amendments regarding nonoperational structure(s).

Applicant argues that physical deposition of a material on the disc subsequent to manufacture which is concurrently readable with the operational structure distinguishes the instant invention over the reference. In response the previous office action described the practice of multiple layers of nonoperational structure in the reference thus making this aspect of the argument non-persuasive and not directed to responding to the basis of the rejection as previously set forth. The deposition of material subsequent to manufacture is a process step limitation within a product claim and therefore results in the claims being interpreted as product by process claims regarding said material deposition. Such process steps do not distinguish a reference which makes the same product by a different process. As noted above the reference does disclose nonoperational structures as instantly claimed and whether they are applied during what is viewed as the manufacturing steps or not does not prevent this rejection as the same product is set forth in the reference as also instantly claimed. Methods of



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making claims remain rejected hereinunder because, as noted in the above vagueness and indefiniteness rejection the distinction between what is a manufacturing step vs. subsequent thereto has not been defined thus resulting in layering steps as in the reference being either during or subsequent to manufacturing depending on some arbitrary and non-limiting manufacturing process step vs. not practice.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 23, 2004

*Ardin H. Marschel* 7/25/04  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER